

**PATENT APPLICATION**

Attorney Docket: 54391

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF APPEALS**

Applicant: Ward

Serial No.: 9/655,987

Filed: 9/6/2000

For: Composition for Protecting Work Surfaces from Contamination

Group Art Unit: 1774

Examiner: Dicus, Tamra

**SUPPLEMENTAL BRIEF FOR APPELLANT**

Hon. Commissioner of Patents

and Trademarks

Washington, D.C. 20231

Sir:

This is a corrected version of an appeal brief, in response to a Notification of Non-Compliance dated 08/19/2008. The previous version of the appeal brief was filed on 07/08/2008 to appeal the decision of the Primary Examiner dated 5/1/2008, finally rejecting Claims 1-8 and 21-28 in the above-identified patent application. Section V of the previously filed brief was rejected on the grounds that the summary of the independent claims was incomplete, in missing claim 23. The present brief cures this defect. Applicant is resubmitting the entire brief for the convenience of the Appeal Board.

Appellant originally filed an appeal after a final rejection dated 6/2/03. The Examiner terminated this first appeal because the Examiner wished to make new grounds for rejection. In addition to the new art rejection, the Examiner made a Section 112, second paragraph rejection that the Examiner could have made in the office action that preceded the first appeal. Because of this untimely new rejection under Section 112, Appellant was forced to abandon the first appeal to correct this Section 112 issue. Were it not for that late Section 112 rejection, Appellant would have re-instated the original appeal, thereby saving the fees in

question. Appellant filed a second appeal on 8/5/04 appealing the new grounds for rejection. The Examiner pointed out an error in the brief in question, and Appellant filed a corrected brief on 10/14/04. The Examiner then rejected the corrected brief because the Examiner maintained that the previously filed brief was defective because the summary of the invention did not contain a concise statement of explanation of the subject matter of each independent claim on appeal and because the grouping of the claims lacked a statement that each group of claims “stand or fall together”. Appellant filed another brief pointing out that the Examiner was in error with respect to the “stand or fall together rejection” and that the Summary of the Invention had not changed since the original brief had been filed and that it met the requirements as proved by insertions indicating which independent claims were discussed at each point in the Summary.

The Examiner then re-opened prosecution again to make yet another new grounds for rejection. Appellant filed a brief to address the new grounds for rejection on 4/27/2006. The Board affirmed all the claims except 19 and 20 in Appellant’s favor on 2/8/2007. Appellant subsequently canceled Claims 19 and 20 in response to an office action citing the decision of the Board and stating that the remaining claims would be allowed.

Instead of allowing the claims as indicated in the above-described office action, the Examiner then re-opened prosecution citing new art. Appellant filed a new appeal addressing the new grounds of rejection and a brief in support thereof on February 4, 2008. The Examiner re-opened prosecution yet again to provide yet another new grounds for rejection in an office action dated 5/1/2008.

The present brief is filed to address the new grounds for rejection presented in the office action dated 5/1/2008. In this office action, the Examiner indicated that Appellant could reinstate the appeal and file a supplemental brief addressing the new grounds for rejection. Appellant hereby elects to reinstate the appeal. This brief is filed to support that appeal.

It is assumed that the Examiner has now withdrawn all previous grounds for rejection that are not part of the rejections in the current office action. However, all previously filed briefs in this application are hereby incorporated by reference and relied upon to address the

earlier grounds for rejection and to provide any missing required information that may be missing from this brief.

## **I. REAL PARTY IN INTEREST**

The real party in interest is Dr. Calvin B. Ward.

## **II. RELATED APPEALS AND INTERFERENCES**

There is a co-pending appeal in 10/278,190, which is a divisional application of this application and that could be affected by the outcome of this appeal.

## **III. STATUS OF THE CLAIMS**

Claims 1-8, and 21-28 are currently pending in this patent application. In the Office Action dated 5/1/2008, the Examiner reopened prosecution and rejected these claims. Claims 9-20 have been canceled. Claims 1-8 and 21-28 are the subject of this appeal.

## **IV. STATUS OF AMENDMENTS**

No amendments have been made since the rejection on 5/1/2008.

## **V. SUMMARY OF THE INVENTION**

The present invention is directed to using a novel sheet to protect a surface by placing this sheet in contact with the surface. The sheet includes an absorbent layer and a water-impermeable electrostatically charged layer. There are seven independent claims, 1, 21, 23, 25, 26, 27, and 28.

With reference to Claim 1, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Sheet 10 is constructed from a water-impermeable electrostatically charged sheet 11 having a top and bottom surface and an absorbent layer 12 (page 3, lines 4-7). The absorbent layer has top and bottom surfaces, the bottom surface of the absorbent layer being bonded to the top surface of the electrostatically charged sheet (page 3, line 7). The absorbent layer is divided into a plurality of cells 14 (page 3, lines 9-11). Liquid is prevented from moving between the cells (page 3, lines 11-12).

With respect to Claim 21, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 21 requires a water-impermeable layer 11 in contact with an absorbent layer 12 (page 3, lines 4-11), wherein the absorbent layer is an open cell foam (page 4, lines 6-11).

With respect to Claim 23, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 21 requires a water-impermeable layer 11 in contact with an absorbent layer 12 (page 3, lines 4-11), wherein the absorbent layer is a fibrous mat (page 4, lines 13-14).

With respect to Claim 25, refer again to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 25 requires an electrostatically charged, water-impermeable layer 11 and absorbent layer 12 (page 3, lines 4-11). The absorbent layer includes a plurality of hydrophobic barriers 13( page 3, line 30) that define the cells and prevent liquid from moving between the cells.

With respect to Claim 26, refer to Figures 1 and 2. The discussion of Figure 2 begins at line 18 of page 4 of the specification. Claim 26 requires an electrostatically charged, water-impermeable layer 11 and absorbent layer 12(page 3, lines 4-11). A hydrophobic layer 21 is bonded to a surface of the absorbent layer and includes a plurality of pores 22(page 4, lines 18-22).

With respect to Claim 27, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. This embodiment includes an electrostatically charged water-impermeable layer 11 and an absorbent layer 12 that are bonded together(page 3, lines 4-11).

With respect to Claim 28 refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. This embodiment includes an electrostatically charged water-impermeable layer 11 and an absorbent layer 12 that are bonded together(page 3, lines 4-11). The absorbent layer is divided into a plurality of cells 14 (page 3, lines 9-11) by a plurality of liquid impermeable barriers 13 that prevent liquid from moving from one cell to another (page 3, lines 11-12).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Rejection of Claims 23 and 27 under 35 U.S.C. 103(a) or 35 U.S.C. 102 (See argument below as to uncertainty with respect to section) as being unpatentable over USPN 4,992,121 to Rubino.

B. Rejection of Claims 1-8, and 21-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 5,888,604 to Evans, Jr. *et al.* (“Evans”) in view of US 4,992,121 to Rubino or alternatively in view of US 6,159,325 to Graham *et al* “Graham”.

## **VII. ARGUMENT**

### **A. Examiner’s Burden**

#### **1. Rejection under 35 U.S.C. 102**

Under 35 U.S.C. 102, the Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). “When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference” (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference.” *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

#### **3. Rejection under 35 U.S.C. 103**

To sustain a rejection under 35 U.S.C. 103, the Examiner must show that the combined references teach each of the elements of the claim or that there is some motivation in the art for altering one of the teachings to arrive at the combined set of teachings. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). In addition, the Examiner must show that there is some motivation in the art that would cause someone of ordinary skill to combine the references, and that in making the combination, there was a reasonable expectation of success. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442(CAFC 1991).

The mere fact that all of the limitations are known separately in the art is not sufficient to sustain a rejection for obviousness. Identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have

suggested to those of ordinary skill in the art. Whether the rejection is based on an express or an implicit showing, there must be particular findings related thereto. *In re Kotzab* (CA FC) 55 USPQ2d 1313, 1316

## **B. Summary of the teachings of the prior art cited by the Examiner**

### **1. Rubino**

Rubino teaches a method of attaching an object such as a poster to a wall by providing an intermediate electrostatically charged sheet of foam that bonds electrostatically to the wall after the foam is attached to the object and subsequently charged by rubbing the foam on an appropriate material. The object to be bonded to the wall is bonded to this foam sheet. The Examiner identifies the poster or other displayed object as the absorbent layer, and the wall as the surface to be protected. Rubino teaches that polystyrene foam can be utilized for the charged sheet of foam. However, Rubino is silent with respect to whether or not the foam sheets taught therein are water impermeable.

### **2. Evans**

Evans teaches a foldable mat for absorbing liquids spilled on a surface such as a floor. Referring to Figure 2 of Evans, and the discussion thereof that begins at column 3, line 23, the mat has a top sheet 10 that is a non-segmented absorbent layer and a plurality of segments 11-14 that are attached to sheet 10 and are in contact with the floor or other surface on which a spill has occurred. Evans teaches that sheet 10 consists of multiple layers of non-segmented **absorbent sheets** bonded together. A wear-resistant surface can be applied to the top of sheet 10. Referring to the paragraph starting at column 4, line 6, Evans teaches that the wear resistant surface may be absorbent or allow fluids to pass through. However, there is no teaching that wear resistant surface 15 is water impermeable. In fact, Figure 4 clearly shows holes in the top of wear resistant surface 15.

### **3. Graham**

Graham teaches a display arrangement in which a charged web (an electret) is attached to a vertical surface and used to hold other objects (manipulatives) in place to form a display in which the manipulatives can be moved around. It should be noted that Graham

teaches that the electret is mounted on the vertical surface by using some form of adhesion other than the electrostatic charge of the electret (Column 6, paragraph beginning at line 2).

**C. Rejection of Claims 23 and 27 under 35 U.S.C. 103(a) or 35 U.S.C. 102 in view of Rubino.**

**1. Uncertainty as to what section is being cited in this rejection**

The Examiner rejected these claims in a section of the office action referring to rejections under 35 U.S.C. 102. In addition, the rejection states that Rubino teaches all of the limitations either implicitly or explicitly. However, the specific rejection in paragraph 4 of the office action refers to section 25 U.S.C. 103(a). Accordingly, Appellant will address both possible rejections.

**2. Rejection of Claims 23 and 27**

Claims 23 and 27 require a water-impermeable electrostatically charged sheet having an absorbent layer in contact with or bonded to the water-impermeable layer. The Examiner identifies the paper poster of Rubino as the absorbent layer and the electrostatically charged foam sheet as the water impermeable layer.

As noted above, Rubino is silent with respect to whether or not the foam sheets taught therein are water impermeable. The Examiner attempts to overcome this problem by stating that Rubino teaches a polystyrene foam sheet, and, since polystyrene is a water impermeable material, the sheets in question are inherently water-impermeable.

First, the Examiner has already admitted that Rubino does not teach that the charged foam sheet of Rubino is water-impermeable (See rejection of Claim 27 under 35 U.S.C. 103(a) over Rubino in view of Sagi in the office action dated 7/23/2007).

Second, polystyrene is a chemical. Whether or not an article made of this chemical is water-impermeable depends on the specific properties of the article. For example, a solid sheet of polystyrene with holes passing through the sheet is clearly water permeable even though it is made from polystyrene. The Examiner has not presented any evidence that the foam sheets of Rubino are water-impermeable. Furthermore, Rubino discloses that foam

sponges can be utilized. A sponge is inherently water permeable, since a water-impermeable sponge would not function for its intended purpose, i.e., picking up water. An open cell foam sheet is inherently water permeable independent of the thickness of the sheet. Even a closed cell foam sheet can be water impermeable depending on the relative thickness of the sheet, whether the area between the cells is filled, and the diameter of the cells. For example, closed cell foam rubber used in wet suits for scuba divers are water permeable. Hence, any sheet of foam can be water permeable. Since inherency requires that the result always be true, Appellant submits that Rubino does not teach an inherently water-impermeable electrostatically charged sheet. Hence, Appellant submits that Rubino does not anticipate Claim 23.

Furthermore, the Examiner has not presented any motivation for altering the teachings of Rubino to arrive at a composition that satisfies the limitations of Claim 23. As noted above, the mere fact that the teachings of a reference can be modified is not sufficient to sustain a rejection under 35 U.S.C. 103. Hence, Appellant submits that the Examiner has not made a *prima facia* case for obviousness with respect to Claim 23.

**D. Rejection of Claims 1-8, and 21-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 5,888,604 to Evans, Jr. *et al.* (“Evans”) in view of US 4,992,121 to Rubino or alternatively in view of US 6,159,325 to Graham *et al* “Graham”.**

**1. Rejection of Claims 1, 25, and 28**

Claims 1, 25, and 28 require a water-impermeable charged sheet bonded to an absorbent layer in which the absorbent layer is divided into a plurality of cells that contain liquid within the boundaries of the cells such that the liquid is prevented from moving between the cells.

The Examiner maintains that Evans teaches all of the limitations of the claim except for the water-impermeable sheet being charged. The Examiner looks to the embodiments shown in Figures 2 and 9. As best Appellant can understand the Examiner’s argument, layers 11-14 correspond to the absorbent layer recited in the claims in question. In this case, layer 10 would need to be the water impermeable sheet to satisfy the limitations of the claims. The

Examiner maintains that the base layers 10 and segmented layers 11-14 have absorbent layers divided by boundaries into segments that contain liquid. The Examiner goes on to maintain that the base layer 10 and the segmented layers 11-14 are hydrophobic and thus water-impermeable.

First, it should be noted that the fact that a layer is hydrophobic does not imply that the layer is water-impermeable. A layer of hydrophobic material with holes therein is not water-impermeable (See layer 21 in Figure 2 of the present application). Second, Evans teaches that both the segmented and non-segmented layers have the capacity to absorb liquids (column 2, first paragraph). If the layers were water-impermeable, the layers could not absorb the liquid in question. In addition, the Examiner states that Evans teaches that the bottom surface of the segmented layer is porous to allow liquid to flow therethrough and be absorbed.

Second, to satisfy the limitations of the claims in question, the top layer 10 shown in Evans would need to be water impermeable. The Examiner has not pointed to any teaching in Evans of a water impermeable layer in this layer. Evans teaches that layer 10 could include various webs including solid webs(column 3, lines 40-62); however, Evans does not teach that layer 10 is water impermeable. In this regard, it should be noted that the wear-resistant surface 15 shown in Figure 2 has holes therein as shown in the figures. It should also be noted that the outer surfaces of the segments also have holes therein (See Figure 1). Hence, the Examiner has failed to show that Evans teaches that layer 10 is water impermeable.

Third, the claims in question require that the absorbent layer be divided into cells and that liquid is prevented from moving between the cells. The Examiner maintains that the segmented layers in Evans have boundaries that prevent liquid from moving between the segmented layers. The Examiner bases this assertion on the fact that there are air gaps between the segmented layers. However, Appellant must point out that the segmented layers are attached to the non-segmented layer 10, which is also absorbent. Hence, liquid can pass from one segmented layer to the other via layer 10. If this were not the case, there would be no reason for layer 10 to be absorbent. Furthermore, the Examiner has not pointed to any teaching that the vertical walls of the segmented layers prevent liquid from escaping from one segment and being reabsorbed by an adjacent segment when someone steps on the first segment thereby compressing that segment and forcing water from it. Hence, Appellant

submits that Evans does not teach all of the limitations of the claims in question with the exception of the water-impermeable sheet being electrostatically charged.

Fourth, the Examiner looks to the secondary references as teaching an electrostatically charged sheet. The Examiner maintains that one would use a charged water-impermeable layer in the mat of Evans because it would allow the mat to be secured to a surface.

Appellant must point out that the surface that is being protected, or against which the mat is placed, is the floor, i.e., the surface that is in contact with the segmented layers. Hence, the Examiner's argument would lead to one electrostatically charging the outer surface of sections 11-14. However, the claim requires that the water-impermeable sheet be charged, i.e., layer 10 in Evans. This layer is not secured against any surface, and hence, there would be no reason to charge that layer.

Finally, it should be noted that if one were to charge the layer that rests against the floor, and hence, are subject to being in contact with the liquid on the floor, the charge would be neutralized by the ions in the liquid during the time of contact, and thus, no electrostatic adhesion would be provided during the time a spill is present by making the modification suggested by the Examiner. Accordingly, Appellant submits that the Examiner has not made a *prima facia* case for obviousness with respect to Claims 1-8 or Claims 25 and 28.

## **2. Rejection of Claims 4 and 6**

Claim 4 requires that the absorbent layer comprises an electrostatically charged open cell foam. Claim 6 requires that the absorbent layer comprises an electrostatically charged fibrous mat. The Examiner admits that Evans does not teach such a limitation. The Examiner looks to Rubino as teaching an electrostatically charged open cell foam. The Examiner also maintains that Rubino teaches an electrostatically charged felt, which satisfies the limitation of a fibrous mat. The Examiner maintains that it would be obvious to use the charged open cell foam of Rubino in sections 11-14 of Evans because the foam is light, flexible, commercially available, and inexpensive.

First, Appellant must point out that none of the properties listed by the Examiner is the result of electrostatically charging the foam. If these properties are sufficient to motivate the use of an open cell foam in Evans, then a non-electrostatically charged foam would work

equally well and be less expensive. Hence, there are additional grounds for allowing Claims 4 and 6.

Second, with respect to Claim 6, Appellant must disagree the Examiner's reading of Rubino. Rubino teaches that the object being held on the electrostatically charged sheet could be felt such as insignia. Rubino does not teach that the objects being held on the wall by the electrostatically charged foam are also electrostatically charged. Hence, there are still further grounds for allowing Claim 6.

### **3. Rejection of Claim 7**

Claim 7 requires that the absorbent layer comprises a plurality of hydrophobic barriers that define the cells. The Examiner maintains that Evans teaches such barriers. Appellant must disagree with the Examiner's reading of the paragraph in question. Evans teaches that the segmented layers can include hydrophobic webs; however, Evans is silent as to where in the segmented layers these appear. The Examiner has not pointed to any teaching in Evans, nor can Appellant find any description in Evans, that the outer surface of the segmented layers is a hydrophobic barrier. Hence, there are additional grounds for allowing Claim 7.

### **4. Rejection of Claims 21, 23, 26, and 27**

Claims 21 and 23 require a water-impermeable charged sheet bonded to an absorbent layer in which the absorbent layer comprises an open cell foam. The Examiner maintains that Evans teaches all of the limitations of the claim except for the water-impermeable sheet being charged. Appellant repeats the arguments made above with respect to the failure of the Examiner to show that layer 10 of Evans is a water-impermeable layer. Appellant also repeats the arguments made above with respect to the motivation to alter layer 10 of Evans such that layer 10 is also electrostatically charged. Accordingly, Appellant submits that the Examiner has failed to make a *prima facia* case for obviousness with respect to Claims 21, 23, 26 27, and the claims dependent therefrom.

### **5. Rejection of Claims 22 and 24.**

Claims 22 and 24 depend from Claims 21 and 23, respectively. Claim 22 requires that the absorbent layer comprises an electrostatically charged open cell foam. Claim 24 requires that the absorbent layer comprises an electrostatically charged fibrous mat. The Examiner

admits that Evans does not teach such a limitation. The Examiner looks to Rubino as teaching an electrostatically charged open cell foam. The Examiner also maintains that Rubino teaches an electrostatically charged felt, which satisfies the limitation of a fibrous mat. The Examiner maintains that it would be obvious to use the charged open cell foam of Rubino in sections 11-14 of Evans because the foam is light, flexible, commercially available, and inexpensive.

Appellant repeats the arguments made above with respect to the rejections of Claims 4 and 6. In particular, none of the properties listed by the Examiner is the result of electrostatically charging the foam; hence, if these properties are sufficient to motivate the use of an open cell foam in Evans, then a non-electrostatically charged foam would work equally well and be less expensive. Hence, there are additional grounds for allowing Claims 22 and 24.

Second, with respect to Claim 24, Appellant must disagree with the Examiner's reading of Rubino. Rubino teaches that the object being held on the electrostatically charged sheet could be felt such as insignia. Rubino does not teach that the objects being held are also electrostatically charged. Hence, there are still further grounds for allowing Claim 24.

## **VIII. CONCLUSION**

Appellant respectfully submits that for the reasons of fact and law argued herein, the decision of the Examiner in finally rejecting Claims 1-8, 21-28 should be reversed.

Respectfully Submitted,



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## **APPENDIX**

### **THE CLAIMS ON APPEAL:**

1. A protective covering comprising:

a water-impermeable electrostatically charged sheet having a top and bottom surface;  
and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being bonded to said top surface of said electrostatically charged sheet, said absorbent layer being divided into a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells.

2. The protective covering of Claim 1, wherein said absorbent layer comprises paper.

3. The protective covering of Claim 1, wherein said absorbent layer comprises an open cell foam.

4. The protective covering of Claim 3, wherein said foam is electrostatically charged.

5. The protective covering of Claim 1, wherein said absorbent layer comprises a fibrous mat.

6. The protective covering of Claim 5, wherein said fibrous mat is electrostatically charged.

7. The protective covering of Claim 1, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining said cells.

8. The protective covering of Claim 1 further comprising a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores

therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

21. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet,

wherein said absorbent layer comprises an open cell foam.

22. The protective covering of Claim 21, wherein said foam is electrostatically charged.

23. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer comprises a fibrous mat.

24. The protective covering of Claim 23, wherein said fibrous mat is electrostatically charged.

25. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining a plurality of cells for containing liquid, said liquid being prevented from moving between said cells by said barriers.

26. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer further comprises a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

27. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said electrostatically charged layer is bonded to said absorbent layer.

28. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer is divided into a plurality of cells for containing liquid by liquid impermeable barriers that prevent liquid from moving from one cell to another.

## **Evidence Appendix**

none

### **Related Proceedings Appendix**

none

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Instead of allowing the claims as indicated in the above-described office action, the Examiner then re-opened prosecution citing new art. Appellant filed a new appeal addressing the new grounds of rejection and a brief in support thereof on February 4, 2008. The Examiner re-opened prosecution yet again to provide yet another new grounds for rejection in an office action dated 5/1/2008.

The present brief is filed to address the new grounds for rejection presented in the office action dated 5/1/2008. In this office action, the Examiner indicated that Appellant could reinstate the appeal and file a supplemental brief addressing the new grounds for rejection. Appellant hereby elects to reinstate the appeal. This brief is filed to support that appeal.

It is assumed that the Examiner has now withdrawn all previous grounds for rejection that are not part of the rejections in the current office action. However, all previously filed briefs in this application are hereby incorporated by reference and relied upon to address the

earlier grounds for rejection and to provide any missing required information that may be missing from this brief.

## **I. REAL PARTY IN INTEREST**

The real party in interest is Dr. Calvin B. Ward.

## **II. RELATED APPEALS AND INTERFERENCES**

There is a co-pending appeal in 10/278,190, which is a divisional application of this application and that could be affected by the outcome of this appeal.

## **III. STATUS OF THE CLAIMS**

Claims 1-8, and 21-28 are currently pending in this patent application. In the Office Action dated 5/1/2008, the Examiner reopened prosecution and rejected these claims. Claims 9-20 have been canceled. Claims 1-8 and 21-28 are the subject of this appeal.

## **IV. STATUS OF AMENDMENTS**

No amendments have been made since the rejection on 5/1/2008.

## **V. SUMMARY OF THE INVENTION**

The present invention is directed to using a novel sheet to protect a surface by placing this sheet in contact with the surface. The sheet includes an absorbent layer and a water-impermeable electrostatically charged layer. There are seven independent claims, 1, 21, 23, 25, 26, 27, and 28.

With reference to Claim 1, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Sheet 10 is constructed from a water-impermeable electrostatically charged sheet 11 having a top and bottom surface and an absorbent layer 12 (page 3, lines 4-7). The absorbent layer has top and bottom surfaces, the bottom surface of the absorbent layer being bonded to the top surface of the electrostatically charged sheet (page 3, line 7). The absorbent layer is divided into a plurality of cells 14 (page 3, lines 9-11). Liquid is prevented from moving between the cells (page 3, lines 11-12).

With respect to Claim 21, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 21 requires a water-impermeable layer 11 in contact with an absorbent layer 12 (page 3, lines 4-11), wherein the absorbent layer is an open cell foam (page 4, lines 6-11).

With respect to Claim 23, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 21 requires a water-impermeable layer 11 in contact with an absorbent layer 12 (page 3, lines 4-11), wherein the absorbent layer is a fibrous mat (page 4, lines 13-14).

With respect to Claim 25, refer again to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 25 requires an electrostatically charged, water-impermeable layer 11 and absorbent layer 12 (page 3, lines 4-11). The absorbent layer includes a plurality of hydrophobic barriers 13( page 3, line 30) that define the cells and prevent liquid from moving between the cells.

With respect to Claim 26, refer to Figures 1 and 2. The discussion of Figure 2 begins at line 18 of page 4 of the specification. Claim 26 requires an electrostatically charged, water-impermeable layer 11 and absorbent layer 12(page 3, lines 4-11). A hydrophobic layer 21 is bonded to a surface of the absorbent layer and includes a plurality of pores 22(page 4, lines 18-22).

With respect to Claim 27, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. This embodiment includes an electrostatically charged water-impermeable layer 11 and an absorbent layer 12 that are bonded together(page 3, lines 4-11).

With respect to Claim 28 refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. This embodiment includes an electrostatically charged water-impermeable layer 11 and an absorbent layer 12 that are bonded together(page 3, lines 4-11). The absorbent layer is divided into a plurality of cells 14 (page 3, lines 9-11) by a plurality of liquid impermeable barriers 13 that prevent liquid from moving from one cell to another (page 3, lines 11-12).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Rejection of Claims 23 and 27 under 35 U.S.C. 103(a) or 35 U.S.C. 102 (See argument below as to uncertainty with respect to section) as being unpatentable over USPN 4,992,121 to Rubino.

B. Rejection of Claims 1-8, and 21-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 5,888,604 to Evans, Jr. *et al.* (“Evans”) in view of US 4,992,121 to Rubino or alternatively in view of US 6,159,325 to Graham *et al* “Graham”.

## **VII. ARGUMENT**

### **A. Examiner’s Burden**

#### **1. Rejection under 35 U.S.C. 102**

Under 35 U.S.C. 102, the Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). “When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference” (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference.” *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

#### **3. Rejection under 35 U.S.C. 103**

To sustain a rejection under 35 U.S.C. 103, the Examiner must show that the combined references teach each of the elements of the claim or that there is some motivation in the art for altering one of the teachings to arrive at the combined set of teachings. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). In addition, the Examiner must show that there is some motivation in the art that would cause someone of ordinary skill to combine the references, and that in making the combination, there was a reasonable expectation of success. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442(CAFC 1991).

The mere fact that all of the limitations are known separately in the art is not sufficient to sustain a rejection for obviousness. Identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have

suggested to those of ordinary skill in the art. Whether the rejection is based on an express or an implicit showing, there must be particular findings related thereto. *In re Kotzab* (CA FC) 55 USPQ2d 1313, 1316

## **B. Summary of the teachings of the prior art cited by the Examiner**

### **1. Rubino**

Rubino teaches a method of attaching an object such as a poster to a wall by providing an intermediate electrostatically charged sheet of foam that bonds electrostatically to the wall after the foam is attached to the object and subsequently charged by rubbing the foam on an appropriate material. The object to be bonded to the wall is bonded to this foam sheet. The Examiner identifies the poster or other displayed object as the absorbent layer, and the wall as the surface to be protected. Rubino teaches that polystyrene foam can be utilized for the charged sheet of foam. However, Rubino is silent with respect to whether or not the foam sheets taught therein are water impermeable.

### **2. Evans**

Evans teaches a foldable mat for absorbing liquids spilled on a surface such as a floor. Referring to Figure 2 of Evans, and the discussion thereof that begins at column 3, line 23, the mat has a top sheet 10 that is a non-segmented absorbent layer and a plurality of segments 11-14 that are attached to sheet 10 and are in contact with the floor or other surface on which a spill has occurred. Evans teaches that sheet 10 consists of multiple layers of non-segmented **absorbent sheets** bonded together. A wear-resistant surface can be applied to the top of sheet 10. Referring to the paragraph starting at column 4, line 6, Evans teaches that the wear resistant surface may be absorbent or allow fluids to pass through. However, there is no teaching that wear resistant surface 15 is water impermeable. In fact, Figure 4 clearly shows holes in the top of wear resistant surface 15.

### **3. Graham**

Graham teaches a display arrangement in which a charged web (an electret) is attached to a vertical surface and used to hold other objects (manipulatives) in place to form a display in which the manipulatives can be moved around. It should be noted that Graham

teaches that the electret is mounted on the vertical surface by using some form of adhesion other than the electrostatic charge of the electret (Column 6, paragraph beginning at line 2).

**C. Rejection of Claims 23 and 27 under 35 U.S.C. 103(a) or 35 U.S.C. 102 in view of Rubino.**

**1. Uncertainty as to what section is being cited in this rejection**

The Examiner rejected these claims in a section of the office action referring to rejections under 35 U.S.C. 102. In addition, the rejection states that Rubino teaches all of the limitations either implicitly or explicitly. However, the specific rejection in paragraph 4 of the office action refers to section 25 U.S.C. 103(a). Accordingly, Appellant will address both possible rejections.

**2. Rejection of Claims 23 and 27**

Claims 23 and 27 require a water-impermeable electrostatically charged sheet having an absorbent layer in contact with or bonded to the water-impermeable layer. The Examiner identifies the paper poster of Rubino as the absorbent layer and the electrostatically charged foam sheet as the water impermeable layer.

As noted above, Rubino is silent with respect to whether or not the foam sheets taught therein are water impermeable. The Examiner attempts to overcome this problem by stating that Rubino teaches a polystyrene foam sheet, and, since polystyrene is a water impermeable material, the sheets in question are inherently water-impermeable.

First, the Examiner has already admitted that Rubino does not teach that the charged foam sheet of Rubino is water-impermeable (See rejection of Claim 27 under 35 U.S.C. 103(a) over Rubino in view of Sagi in the office action dated 7/23/2007).

Second, polystyrene is a chemical. Whether or not an article made of this chemical is water-impermeable depends on the specific properties of the article. For example, a solid sheet of polystyrene with holes passing through the sheet is clearly water permeable even though it is made from polystyrene. The Examiner has not presented any evidence that the foam sheets of Rubino are water-impermeable. Furthermore, Rubino discloses that foam

sponges can be utilized. A sponge is inherently water permeable, since a water-impermeable sponge would not function for its intended purpose, i.e., picking up water. An open cell foam sheet is inherently water permeable independent of the thickness of the sheet. Even a closed cell foam sheet can be water impermeable depending on the relative thickness of the sheet, whether the area between the cells is filled, and the diameter of the cells. For example, closed cell foam rubber used in wet suits for scuba divers are water permeable. Hence, any sheet of foam can be water permeable. Since inherency requires that the result always be true, Appellant submits that Rubino does not teach an inherently water-impermeable electrostatically charged sheet. Hence, Appellant submits that Rubino does not anticipate Claim 23.

Furthermore, the Examiner has not presented any motivation for altering the teachings of Rubino to arrive at a composition that satisfies the limitations of Claim 23. As noted above, the mere fact that the teachings of a reference can be modified is not sufficient to sustain a rejection under 35 U.S.C. 103. Hence, Appellant submits that the Examiner has not made a *prima facia* case for obviousness with respect to Claim 23.

**D. Rejection of Claims 1-8, and 21-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 5,888,604 to Evans, Jr. *et al.* (“Evans”) in view of US 4,992,121 to Rubino or alternatively in view of US 6,159,325 to Graham *et al* “Graham”.**

**1. Rejection of Claims 1, 25, and 28**

Claims 1, 25, and 28 require a water-impermeable charged sheet bonded to an absorbent layer in which the absorbent layer is divided into a plurality of cells that contain liquid within the boundaries of the cells such that the liquid is prevented from moving between the cells.

The Examiner maintains that Evans teaches all of the limitations of the claim except for the water-impermeable sheet being charged. The Examiner looks to the embodiments shown in Figures 2 and 9. As best Appellant can understand the Examiner’s argument, layers 11-14 correspond to the absorbent layer recited in the claims in question. In this case, layer 10 would need to be the water impermeable sheet to satisfy the limitations of the claims. The

Examiner maintains that the base layers 10 and segmented layers 11-14 have absorbent layers divided by boundaries into segments that contain liquid. The Examiner goes on to maintain that the base layer 10 and the segmented layers 11-14 are hydrophobic and thus water-impermeable.

First, it should be noted that the fact that a layer is hydrophobic does not imply that the layer is water-impermeable. A layer of hydrophobic material with holes therein is not water-impermeable (See layer 21 in Figure 2 of the present application). Second, Evans teaches that both the segmented and non-segmented layers have the capacity to absorb liquids (column 2, first paragraph). If the layers were water-impermeable, the layers could not absorb the liquid in question. In addition, the Examiner states that Evans teaches that the bottom surface of the segmented layer is porous to allow liquid to flow therethrough and be absorbed.

Second, to satisfy the limitations of the claims in question, the top layer 10 shown in Evans would need to be water impermeable. The Examiner has not pointed to any teaching in Evans of a water impermeable layer in this layer. Evans teaches that layer 10 could include various webs including solid webs(column 3, lines 40-62); however, Evans does not teach that layer 10 is water impermeable. In this regard, it should be noted that the wear-resistant surface 15 shown in Figure 2 has holes therein as shown in the figures. It should also be noted that the outer surfaces of the segments also have holes therein (See Figure 1). Hence, the Examiner has failed to show that Evans teaches that layer 10 is water impermeable.

Third, the claims in question require that the absorbent layer be divided into cells and that liquid is prevented from moving between the cells. The Examiner maintains that the segmented layers in Evans have boundaries that prevent liquid from moving between the segmented layers. The Examiner bases this assertion on the fact that there are air gaps between the segmented layers. However, Appellant must point out that the segmented layers are attached to the non-segmented layer 10, which is also absorbent. Hence, liquid can pass from one segmented layer to the other via layer 10. If this were not the case, there would be no reason for layer 10 to be absorbent. Furthermore, the Examiner has not pointed to any teaching that the vertical walls of the segmented layers prevent liquid from escaping from one segment and being reabsorbed by an adjacent segment when someone steps on the first segment thereby compressing that segment and forcing water from it. Hence, Appellant

submits that Evans does not teach all of the limitations of the claims in question with the exception of the water-impermeable sheet being electrostatically charged.

Fourth, the Examiner looks to the secondary references as teaching an electrostatically charged sheet. The Examiner maintains that one would use a charged water-impermeable layer in the mat of Evans because it would allow the mat to be secured to a surface.

Appellant must point out that the surface that is being protected, or against which the mat is placed, is the floor, i.e., the surface that is in contact with the segmented layers. Hence, the Examiner's argument would lead to one electrostatically charging the outer surface of sections 11-14. However, the claim requires that the water-impermeable sheet be charged, i.e., layer 10 in Evans. This layer is not secured against any surface, and hence, there would be no reason to charge that layer.

Finally, it should be noted that if one were to charge the layer that rests against the floor, and hence, are subject to being in contact with the liquid on the floor, the charge would be neutralized by the ions in the liquid during the time of contact, and thus, no electrostatic adhesion would be provided during the time a spill is present by making the modification suggested by the Examiner. Accordingly, Appellant submits that the Examiner has not made a *prima facia* case for obviousness with respect to Claims 1-8 or Claims 25 and 28.

## **2. Rejection of Claims 4 and 6**

Claim 4 requires that the absorbent layer comprises an electrostatically charged open cell foam. Claim 6 requires that the absorbent layer comprises an electrostatically charged fibrous mat. The Examiner admits that Evans does not teach such a limitation. The Examiner looks to Rubino as teaching an electrostatically charged open cell foam. The Examiner also maintains that Rubino teaches an electrostatically charged felt, which satisfies the limitation of a fibrous mat. The Examiner maintains that it would be obvious to use the charged open cell foam of Rubino in sections 11-14 of Evans because the foam is light, flexible, commercially available, and inexpensive.

First, Appellant must point out that none of the properties listed by the Examiner is the result of electrostatically charging the foam. If these properties are sufficient to motivate the use of an open cell foam in Evans, then a non-electrostatically charged foam would work

equally well and be less expensive. Hence, there are additional grounds for allowing Claims 4 and 6.

Second, with respect to Claim 6, Appellant must disagree the Examiner's reading of Rubino. Rubino teaches that the object being held on the electrostatically charged sheet could be felt such as insignia. Rubino does not teach that the objects being held on the wall by the electrostatically charged foam are also electrostatically charged. Hence, there are still further grounds for allowing Claim 6.

### **3. Rejection of Claim 7**

Claim 7 requires that the absorbent layer comprises a plurality of hydrophobic barriers that define the cells. The Examiner maintains that Evans teaches such barriers. Appellant must disagree with the Examiner's reading of the paragraph in question. Evans teaches that the segmented layers can include hydrophobic webs; however, Evans is silent as to where in the segmented layers these appear. The Examiner has not pointed to any teaching in Evans, nor can Appellant find any description in Evans, that the outer surface of the segmented layers is a hydrophobic barrier. Hence, there are additional grounds for allowing Claim 7.

### **4. Rejection of Claims 21, 23, 26, and 27**

Claims 21 and 23 require a water-impermeable charged sheet bonded to an absorbent layer in which the absorbent layer comprises an open cell foam. The Examiner maintains that Evans teaches all of the limitations of the claim except for the water-impermeable sheet being charged. Appellant repeats the arguments made above with respect to the failure of the Examiner to show that layer 10 of Evans is a water-impermeable layer. Appellant also repeats the arguments made above with respect to the motivation to alter layer 10 of Evans such that layer 10 is also electrostatically charged. Accordingly, Appellant submits that the Examiner has failed to make a *prima facia* case for obviousness with respect to Claims 21, 23, 26 27, and the claims dependent therefrom.

### **5. Rejection of Claims 22 and 24.**

Claims 22 and 24 depend from Claims 21 and 23, respectively. Claim 22 requires that the absorbent layer comprises an electrostatically charged open cell foam. Claim 24 requires that the absorbent layer comprises an electrostatically charged fibrous mat. The Examiner

admits that Evans does not teach such a limitation. The Examiner looks to Rubino as teaching an electrostatically charged open cell foam. The Examiner also maintains that Rubino teaches an electrostatically charged felt, which satisfies the limitation of a fibrous mat. The Examiner maintains that it would be obvious to use the charged open cell foam of Rubino in sections 11-14 of Evans because the foam is light, flexible, commercially available, and inexpensive.

Appellant repeats the arguments made above with respect to the rejections of Claims 4 and 6. In particular, none of the properties listed by the Examiner is the result of electrostatically charging the foam; hence, if these properties are sufficient to motivate the use of an open cell foam in Evans, then a non-electrostatically charged foam would work equally well and be less expensive. Hence, there are additional grounds for allowing Claims 22 and 24.

Second, with respect to Claim 24, Appellant must disagree with the Examiner's reading of Rubino. Rubino teaches that the object being held on the electrostatically charged sheet could be felt such as insignia. Rubino does not teach that the objects being held are also electrostatically charged. Hence, there are still further grounds for allowing Claim 24.

## **VIII. CONCLUSION**

Appellant respectfully submits that for the reasons of fact and law argued herein, the decision of the Examiner in finally rejecting Claims 1-8, 21-28 should be reversed.

Respectfully Submitted,



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## **APPENDIX**

### **THE CLAIMS ON APPEAL:**

1. A protective covering comprising:

a water-impermeable electrostatically charged sheet having a top and bottom surface;  
and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being bonded to said top surface of said electrostatically charged sheet, said absorbent layer being divided into a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells.

2. The protective covering of Claim 1, wherein said absorbent layer comprises paper.

3. The protective covering of Claim 1, wherein said absorbent layer comprises an open cell foam.

4. The protective covering of Claim 3, wherein said foam is electrostatically charged.

5. The protective covering of Claim 1, wherein said absorbent layer comprises a fibrous mat.

6. The protective covering of Claim 5, wherein said fibrous mat is electrostatically charged.

7. The protective covering of Claim 1, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining said cells.

8. The protective covering of Claim 1 further comprising a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores

therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

21. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet,

wherein said absorbent layer comprises an open cell foam.

22. The protective covering of Claim 21, wherein said foam is electrostatically charged.

23. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer comprises a fibrous mat.

24. The protective covering of Claim 23, wherein said fibrous mat is electrostatically charged.

25. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining a plurality of cells for containing liquid, said liquid being prevented from moving between said cells by said barriers.

26. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer further comprises a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

27. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said electrostatically charged layer is bonded to said absorbent layer.

28. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer is divided into a plurality of cells for containing liquid by liquid impermeable barriers that prevent liquid from moving from one cell to another.

## **Evidence Appendix**

none

### **Related Proceedings Appendix**

none

**PATENT APPLICATION**

Attorney Docket: 54391

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF APPEALS**

Applicant: Ward

Serial No.: 9/655,987

Filed: 9/6/2000

For: Composition for Protecting Work Surfaces from Contamination

Group Art Unit: 1774

Examiner: Dicus, Tamra

**SUPPLEMENTAL BRIEF FOR APPELLANT**

Hon. Commissioner of Patents

and Trademarks

Washington, D.C. 20231

Sir:

This is a corrected version of an appeal brief, in response to a Notification of Non-Compliance dated 08/19/2008. The previous version of the appeal brief was filed on 07/08/2008 to appeal the decision of the Primary Examiner dated 5/1/2008, finally rejecting Claims 1-8 and 21-28 in the above-identified patent application. Section V of the previously filed brief was rejected on the grounds that the summary of the independent claims was incomplete, in missing claim 23. The present brief cures this defect. Applicant is refiling the entire brief for the convenience of the Appeal Board.

Appellant originally filed an appeal after a final rejection dated 6/2/03. The Examiner terminated this first appeal because the Examiner wished to make new grounds for rejection. In addition to the new art rejection, the Examiner made a Section 112, second paragraph rejection that the Examiner could have made in the office action that preceded the first appeal. Because of this untimely new rejection under Section 112, Appellant was forced to abandon the first appeal to correct this Section 112 issue. Were it not for that late Section 112 rejection, Appellant would have re-instated the original appeal, thereby saving the fees in

question. Appellant filed a second appeal on 8/5/04 appealing the new grounds for rejection. The Examiner pointed out an error in the brief in question, and Appellant filed a corrected brief on 10/14/04. The Examiner then rejected the corrected brief because the Examiner maintained that the previously filed brief was defective because the summary of the invention did not contain a concise statement of explanation of the subject matter of each independent claim on appeal and because the grouping of the claims lacked a statement that each group of claims “stand or fall together”. Appellant filed another brief pointing out that the Examiner was in error with respect to the “stand or fall together rejection” and that the Summary of the Invention had not changed since the original brief had been filed and that it met the requirements as proved by insertions indicating which independent claims were discussed at each point in the Summary.

The Examiner then re-opened prosecution again to make yet another new grounds for rejection. Appellant filed a brief to address the new grounds for rejection on 4/27/2006. The Board affirmed all the claims except 19 and 20 in Appellant’s favor on 2/8/2007. Appellant subsequently canceled Claims 19 and 20 in response to an office action citing the decision of the Board and stating that the remaining claims would be allowed.

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The present brief is filed to address the new grounds for rejection presented in the office action dated 5/1/2008. In this office action, the Examiner indicated that Appellant could reinstate the appeal and file a supplemental brief addressing the new grounds for rejection. Appellant hereby elects to reinstate the appeal. This brief is filed to support that appeal.

It is assumed that the Examiner has now withdrawn all previous grounds for rejection that are not part of the rejections in the current office action. However, all previously filed briefs in this application are hereby incorporated by reference and relied upon to address the

earlier grounds for rejection and to provide any missing required information that may be missing from this brief.

## **I. REAL PARTY IN INTEREST**

The real party in interest is Dr. Calvin B. Ward.

## **II. RELATED APPEALS AND INTERFERENCES**

There is a co-pending appeal in 10/278,190, which is a divisional application of this application and that could be affected by the outcome of this appeal.

## **III. STATUS OF THE CLAIMS**

Claims 1-8, and 21-28 are currently pending in this patent application. In the Office Action dated 5/1/2008, the Examiner reopened prosecution and rejected these claims. Claims 9-20 have been canceled. Claims 1-8 and 21-28 are the subject of this appeal.

## **IV. STATUS OF AMENDMENTS**

No amendments have been made since the rejection on 5/1/2008.

## **V. SUMMARY OF THE INVENTION**

The present invention is directed to using a novel sheet to protect a surface by placing this sheet in contact with the surface. The sheet includes an absorbent layer and a water-impermeable electrostatically charged layer. There are seven independent claims, 1, 21, 23, 25, 26, 27, and 28.

With reference to Claim 1, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Sheet 10 is constructed from a water-impermeable electrostatically charged sheet 11 having a top and bottom surface and an absorbent layer 12 (page 3, lines 4-7). The absorbent layer has top and bottom surfaces, the bottom surface of the absorbent layer being bonded to the top surface of the electrostatically charged sheet (page 3, line 7). The absorbent layer is divided into a plurality of cells 14 (page 3, lines 9-11). Liquid is prevented from moving between the cells (page 3, lines 11-12).

With respect to Claim 21, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 21 requires a water-impermeable layer 11 in contact with an absorbent layer 12 (page 3, lines 4-11), wherein the absorbent layer is an open cell foam (page 4, lines 6-11).

With respect to Claim 23, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 21 requires a water-impermeable layer 11 in contact with an absorbent layer 12 (page 3, lines 4-11), wherein the absorbent layer is a fibrous mat (page 4, lines 13-14).

With respect to Claim 25, refer again to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. Claim 25 requires an electrostatically charged, water-impermeable layer 11 and absorbent layer 12 (page 3, lines 4-11). The absorbent layer includes a plurality of hydrophobic barriers 13( page 3, line 30) that define the cells and prevent liquid from moving between the cells.

With respect to Claim 26, refer to Figures 1 and 2. The discussion of Figure 2 begins at line 18 of page 4 of the specification. Claim 26 requires an electrostatically charged, water-impermeable layer 11 and absorbent layer 12(page 3, lines 4-11). A hydrophobic layer 21 is bonded to a surface of the absorbent layer and includes a plurality of pores 22(page 4, lines 18-22).

With respect to Claim 27, refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. This embodiment includes an electrostatically charged water-impermeable layer 11 and an absorbent layer 12 that are bonded together(page 3, lines 4-11).

With respect to Claim 28 refer to Figure 1 and the discussion thereof that begins at line 4 of page 3 of the specification. This embodiment includes an electrostatically charged water-impermeable layer 11 and an absorbent layer 12 that are bonded together(page 3, lines 4-11). The absorbent layer is divided into a plurality of cells 14 (page 3, lines 9-11) by a plurality of liquid impermeable barriers 13 that prevent liquid from moving from one cell to another (page 3, lines 11-12).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

A. Rejection of Claims 23 and 27 under 35 U.S.C. 103(a) or 35 U.S.C. 102 (See argument below as to uncertainty with respect to section) as being unpatentable over USPN 4,992,121 to Rubino.

B. Rejection of Claims 1-8, and 21-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 5,888,604 to Evans, Jr. *et al.* (“Evans”) in view of US 4,992,121 to Rubino or alternatively in view of US 6,159,325 to Graham *et al* “Graham”.

## **VII. ARGUMENT**

### **A. Examiner’s Burden**

#### **1. Rejection under 35 U.S.C. 102**

Under 35 U.S.C. 102, the Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). “When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference” (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference.” *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

#### **3. Rejection under 35 U.S.C. 103**

To sustain a rejection under 35 U.S.C. 103, the Examiner must show that the combined references teach each of the elements of the claim or that there is some motivation in the art for altering one of the teachings to arrive at the combined set of teachings. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). In addition, the Examiner must show that there is some motivation in the art that would cause someone of ordinary skill to combine the references, and that in making the combination, there was a reasonable expectation of success. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442(CAFC 1991).

The mere fact that all of the limitations are known separately in the art is not sufficient to sustain a rejection for obviousness. Identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have

suggested to those of ordinary skill in the art. Whether the rejection is based on an express or an implicit showing, there must be particular findings related thereto. *In re Kotzab* (CA FC) 55 USPQ2d 1313, 1316

## **B. Summary of the teachings of the prior art cited by the Examiner**

### **1. Rubino**

Rubino teaches a method of attaching an object such as a poster to a wall by providing an intermediate electrostatically charged sheet of foam that bonds electrostatically to the wall after the foam is attached to the object and subsequently charged by rubbing the foam on an appropriate material. The object to be bonded to the wall is bonded to this foam sheet. The Examiner identifies the poster or other displayed object as the absorbent layer, and the wall as the surface to be protected. Rubino teaches that polystyrene foam can be utilized for the charged sheet of foam. However, Rubino is silent with respect to whether or not the foam sheets taught therein are water impermeable.

### **2. Evans**

Evans teaches a foldable mat for absorbing liquids spilled on a surface such as a floor. Referring to Figure 2 of Evans, and the discussion thereof that begins at column 3, line 23, the mat has a top sheet 10 that is a non-segmented absorbent layer and a plurality of segments 11-14 that are attached to sheet 10 and are in contact with the floor or other surface on which a spill has occurred. Evans teaches that sheet 10 consists of multiple layers of non-segmented **absorbent sheets** bonded together. A wear-resistant surface can be applied to the top of sheet 10. Referring to the paragraph starting at column 4, line 6, Evans teaches that the wear resistant surface may be absorbent or allow fluids to pass through. However, there is no teaching that wear resistant surface 15 is water impermeable. In fact, Figure 4 clearly shows holes in the top of wear resistant surface 15.

### **3. Graham**

Graham teaches a display arrangement in which a charged web (an electret) is attached to a vertical surface and used to hold other objects (manipulatives) in place to form a display in which the manipulatives can be moved around. It should be noted that Graham

teaches that the electret is mounted on the vertical surface by using some form of adhesion other than the electrostatic charge of the electret (Column 6, paragraph beginning at line 2).

**C. Rejection of Claims 23 and 27 under 35 U.S.C. 103(a) or 35 U.S.C. 102 in view of Rubino.**

**1. Uncertainty as to what section is being cited in this rejection**

The Examiner rejected these claims in a section of the office action referring to rejections under 35 U.S.C. 102. In addition, the rejection states that Rubino teaches all of the limitations either implicitly or explicitly. However, the specific rejection in paragraph 4 of the office action refers to section 25 U.S.C. 103(a). Accordingly, Appellant will address both possible rejections.

**2. Rejection of Claims 23 and 27**

Claims 23 and 27 require a water-impermeable electrostatically charged sheet having an absorbent layer in contact with or bonded to the water-impermeable layer. The Examiner identifies the paper poster of Rubino as the absorbent layer and the electrostatically charged foam sheet as the water impermeable layer.

As noted above, Rubino is silent with respect to whether or not the foam sheets taught therein are water impermeable. The Examiner attempts to overcome this problem by stating that Rubino teaches a polystyrene foam sheet, and, since polystyrene is a water impermeable material, the sheets in question are inherently water-impermeable.

First, the Examiner has already admitted that Rubino does not teach that the charged foam sheet of Rubino is water-impermeable (See rejection of Claim 27 under 35 U.S.C. 103(a) over Rubino in view of Sagi in the office action dated 7/23/2007).

Second, polystyrene is a chemical. Whether or not an article made of this chemical is water-impermeable depends on the specific properties of the article. For example, a solid sheet of polystyrene with holes passing through the sheet is clearly water permeable even though it is made from polystyrene. The Examiner has not presented any evidence that the foam sheets of Rubino are water-impermeable. Furthermore, Rubino discloses that foam

sponges can be utilized. A sponge is inherently water permeable, since a water-impermeable sponge would not function for its intended purpose, i.e., picking up water. An open cell foam sheet is inherently water permeable independent of the thickness of the sheet. Even a closed cell foam sheet can be water impermeable depending on the relative thickness of the sheet, whether the area between the cells is filled, and the diameter of the cells. For example, closed cell foam rubber used in wet suits for scuba divers are water permeable. Hence, any sheet of foam can be water permeable. Since inherency requires that the result always be true, Appellant submits that Rubino does not teach an inherently water-impermeable electrostatically charged sheet. Hence, Appellant submits that Rubino does not anticipate Claim 23.

Furthermore, the Examiner has not presented any motivation for altering the teachings of Rubino to arrive at a composition that satisfies the limitations of Claim 23. As noted above, the mere fact that the teachings of a reference can be modified is not sufficient to sustain a rejection under 35 U.S.C. 103. Hence, Appellant submits that the Examiner has not made a *prima facia* case for obviousness with respect to Claim 23.

**D. Rejection of Claims 1-8, and 21-28 under 35 U.S.C. 103(a) as being unpatentable over USPN 5,888,604 to Evans, Jr. *et al.* (“Evans”) in view of US 4,992,121 to Rubino or alternatively in view of US 6,159,325 to Graham *et al* “Graham”.**

**1. Rejection of Claims 1, 25, and 28**

Claims 1, 25, and 28 require a water-impermeable charged sheet bonded to an absorbent layer in which the absorbent layer is divided into a plurality of cells that contain liquid within the boundaries of the cells such that the liquid is prevented from moving between the cells.

The Examiner maintains that Evans teaches all of the limitations of the claim except for the water-impermeable sheet being charged. The Examiner looks to the embodiments shown in Figures 2 and 9. As best Appellant can understand the Examiner’s argument, layers 11-14 correspond to the absorbent layer recited in the claims in question. In this case, layer 10 would need to be the water impermeable sheet to satisfy the limitations of the claims. The

Examiner maintains that the base layers 10 and segmented layers 11-14 have absorbent layers divided by boundaries into segments that contain liquid. The Examiner goes on to maintain that the base layer 10 and the segmented layers 11-14 are hydrophobic and thus water-impermeable.

First, it should be noted that the fact that a layer is hydrophobic does not imply that the layer is water-impermeable. A layer of hydrophobic material with holes therein is not water-impermeable (See layer 21 in Figure 2 of the present application). Second, Evans teaches that both the segmented and non-segmented layers have the capacity to absorb liquids (column 2, first paragraph). If the layers were water-impermeable, the layers could not absorb the liquid in question. In addition, the Examiner states that Evans teaches that the bottom surface of the segmented layer is porous to allow liquid to flow therethrough and be absorbed.

Second, to satisfy the limitations of the claims in question, the top layer 10 shown in Evans would need to be water impermeable. The Examiner has not pointed to any teaching in Evans of a water impermeable layer in this layer. Evans teaches that layer 10 could include various webs including solid webs(column 3, lines 40-62); however, Evans does not teach that layer 10 is water impermeable. In this regard, it should be noted that the wear-resistant surface 15 shown in Figure 2 has holes therein as shown in the figures. It should also be noted that the outer surfaces of the segments also have holes therein (See Figure 1). Hence, the Examiner has failed to show that Evans teaches that layer 10 is water impermeable.

Third, the claims in question require that the absorbent layer be divided into cells and that liquid is prevented from moving between the cells. The Examiner maintains that the segmented layers in Evans have boundaries that prevent liquid from moving between the segmented layers. The Examiner bases this assertion on the fact that there are air gaps between the segmented layers. However, Appellant must point out that the segmented layers are attached to the non-segmented layer 10, which is also absorbent. Hence, liquid can pass from one segmented layer to the other via layer 10. If this were not the case, there would be no reason for layer 10 to be absorbent. Furthermore, the Examiner has not pointed to any teaching that the vertical walls of the segmented layers prevent liquid from escaping from one segment and being reabsorbed by an adjacent segment when someone steps on the first segment thereby compressing that segment and forcing water from it. Hence, Appellant

submits that Evans does not teach all of the limitations of the claims in question with the exception of the water-impermeable sheet being electrostatically charged.

Fourth, the Examiner looks to the secondary references as teaching an electrostatically charged sheet. The Examiner maintains that one would use a charged water-impermeable layer in the mat of Evans because it would allow the mat to be secured to a surface.

Appellant must point out that the surface that is being protected, or against which the mat is placed, is the floor, i.e., the surface that is in contact with the segmented layers. Hence, the Examiner's argument would lead to one electrostatically charging the outer surface of sections 11-14. However, the claim requires that the water-impermeable sheet be charged, i.e., layer 10 in Evans. This layer is not secured against any surface, and hence, there would be no reason to charge that layer.

Finally, it should be noted that if one were to charge the layer that rests against the floor, and hence, are subject to being in contact with the liquid on the floor, the charge would be neutralized by the ions in the liquid during the time of contact, and thus, no electrostatic adhesion would be provided during the time a spill is present by making the modification suggested by the Examiner. Accordingly, Appellant submits that the Examiner has not made a *prima facia* case for obviousness with respect to Claims 1-8 or Claims 25 and 28.

## **2. Rejection of Claims 4 and 6**

Claim 4 requires that the absorbent layer comprises an electrostatically charged open cell foam. Claim 6 requires that the absorbent layer comprises an electrostatically charged fibrous mat. The Examiner admits that Evans does not teach such a limitation. The Examiner looks to Rubino as teaching an electrostatically charged open cell foam. The Examiner also maintains that Rubino teaches an electrostatically charged felt, which satisfies the limitation of a fibrous mat. The Examiner maintains that it would be obvious to use the charged open cell foam of Rubino in sections 11-14 of Evans because the foam is light, flexible, commercially available, and inexpensive.

First, Appellant must point out that none of the properties listed by the Examiner is the result of electrostatically charging the foam. If these properties are sufficient to motivate the use of an open cell foam in Evans, then a non-electrostatically charged foam would work

equally well and be less expensive. Hence, there are additional grounds for allowing Claims 4 and 6.

Second, with respect to Claim 6, Appellant must disagree the Examiner's reading of Rubino. Rubino teaches that the object being held on the electrostatically charged sheet could be felt such as insignia. Rubino does not teach that the objects being held on the wall by the electrostatically charged foam are also electrostatically charged. Hence, there are still further grounds for allowing Claim 6.

### **3. Rejection of Claim 7**

Claim 7 requires that the absorbent layer comprises a plurality of hydrophobic barriers that define the cells. The Examiner maintains that Evans teaches such barriers. Appellant must disagree with the Examiner's reading of the paragraph in question. Evans teaches that the segmented layers can include hydrophobic webs; however, Evans is silent as to where in the segmented layers these appear. The Examiner has not pointed to any teaching in Evans, nor can Appellant find any description in Evans, that the outer surface of the segmented layers is a hydrophobic barrier. Hence, there are additional grounds for allowing Claim 7.

### **4. Rejection of Claims 21, 23, 26, and 27**

Claims 21 and 23 require a water-impermeable charged sheet bonded to an absorbent layer in which the absorbent layer comprises an open cell foam. The Examiner maintains that Evans teaches all of the limitations of the claim except for the water-impermeable sheet being charged. Appellant repeats the arguments made above with respect to the failure of the Examiner to show that layer 10 of Evans is a water-impermeable layer. Appellant also repeats the arguments made above with respect to the motivation to alter layer 10 of Evans such that layer 10 is also electrostatically charged. Accordingly, Appellant submits that the Examiner has failed to make a *prima facia* case for obviousness with respect to Claims 21, 23, 26 27, and the claims dependent therefrom.

### **5. Rejection of Claims 22 and 24.**

Claims 22 and 24 depend from Claims 21 and 23, respectively. Claim 22 requires that the absorbent layer comprises an electrostatically charged open cell foam. Claim 24 requires that the absorbent layer comprises an electrostatically charged fibrous mat. The Examiner

admits that Evans does not teach such a limitation. The Examiner looks to Rubino as teaching an electrostatically charged open cell foam. The Examiner also maintains that Rubino teaches an electrostatically charged felt, which satisfies the limitation of a fibrous mat. The Examiner maintains that it would be obvious to use the charged open cell foam of Rubino in sections 11-14 of Evans because the foam is light, flexible, commercially available, and inexpensive.

Appellant repeats the arguments made above with respect to the rejections of Claims 4 and 6. In particular, none of the properties listed by the Examiner is the result of electrostatically charging the foam; hence, if these properties are sufficient to motivate the use of an open cell foam in Evans, then a non-electrostatically charged foam would work equally well and be less expensive. Hence, there are additional grounds for allowing Claims 22 and 24.

Second, with respect to Claim 24, Appellant must disagree with the Examiner's reading of Rubino. Rubino teaches that the object being held on the electrostatically charged sheet could be felt such as insignia. Rubino does not teach that the objects being held are also electrostatically charged. Hence, there are still further grounds for allowing Claim 24.

## **VIII. CONCLUSION**

Appellant respectfully submits that for the reasons of fact and law argued herein, the decision of the Examiner in finally rejecting Claims 1-8, 21-28 should be reversed.

Respectfully Submitted,



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## **APPENDIX**

### **THE CLAIMS ON APPEAL:**

1. A protective covering comprising:

a water-impermeable electrostatically charged sheet having a top and bottom surface;  
and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being bonded to said top surface of said electrostatically charged sheet, said absorbent layer being divided into a plurality of cells for containing liquid within the boundaries of said cells, said liquid being prevented from moving between said cells.

2. The protective covering of Claim 1, wherein said absorbent layer comprises paper.

3. The protective covering of Claim 1, wherein said absorbent layer comprises an open cell foam.

4. The protective covering of Claim 3, wherein said foam is electrostatically charged.

5. The protective covering of Claim 1, wherein said absorbent layer comprises a fibrous mat.

6. The protective covering of Claim 5, wherein said fibrous mat is electrostatically charged.

7. The protective covering of Claim 1, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining said cells.

8. The protective covering of Claim 1 further comprising a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores

therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

21. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet,

wherein said absorbent layer comprises an open cell foam.

22. The protective covering of Claim 21, wherein said foam is electrostatically charged.

23. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer comprises a fibrous mat.

24. The protective covering of Claim 23, wherein said fibrous mat is electrostatically charged.

25. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer comprises a plurality of hydrophobic barriers, said hydrophobic barriers defining a plurality of cells for containing liquid, said liquid being prevented from moving between said cells by said barriers.

26. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer further comprises a hydrophobic layer bonded to said top surface of said absorbent layer, said hydrophobic layer having a plurality of pores therethrough, said pores allowing liquid to penetrate said hydrophobic layer and be absorbed by said absorbent layer.

27. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said electrostatically charged layer is bonded to said absorbent layer.

28. A protective covering for protecting an exposed surface:

a water-impermeable electrostatically charged sheet having a top and bottom surface; and

an absorbent layer having top and bottom surfaces, said bottom surface of said absorbent layer being in contact with said top surface of said electrostatically charged sheet, wherein said absorbent layer is divided into a plurality of cells for containing liquid by liquid impermeable barriers that prevent liquid from moving from one cell to another.

## **Evidence Appendix**

none

### **Related Proceedings Appendix**

none